DETAILED ACTION

1.   This office action is in response to applicants' communication filed on September 13,

2011. Amendments to claims 1 and 42 have been entered. Claims 1, 8, 16, 17, 19, 20, 22, 25, 27,

28, 42, 43, 50, 51, 53, 54, 56, 61 and 68-71 are currently pending and have been examined. The

objections to the specification, rejections and response to arguments are stated below.

Specification

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

3.   The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support

the subject matter set forth in the claims. The specification, as originally filed does not provide

support for the invention as now claimed.

      The test to be applied under the written description portion of 35 U.S.C. § 112, first

paragraph, is whether the disclosure of the application as originally filed reasonably conveys to

the artisan that the inventor had possession at that time of later claimed subject matter. *Vas-Cat,*

Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied

(,Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

      Claims 1 and 42 include the limitation of "information identifying specific merchant

locations, *if any,* and information identifying specific communications networks for carrying or

transmitting stored value card processing requests, *if any,* that are authorized to transact

specific processing requests for a stored value card, each of the specific merchant locations and

specific communications networks identified by an identifier", and "*capturing an identifier of*

the originating merchant location from which the specific processing request was sent over the

originating communications network, deeming that the originating merchant location is a

trusted source based upon its use of a trusted communications network, and storing the

captured identifier of the originating merchant location in the database as a trusted merchant

location for future processing requests, if not already stored in the database".(emphases added).

However, the specification does not provide a written description disclosure to support

the claimed limitations of "information identifying specific merchant locations, if any, and

information identifying specific communications networks for carrying or transmitting stored

value card processing requests, if any, that are authorized to transact specific processing

requests for a stored value card, each of the specific merchant locations and specific

communications networks identified by an identifier", and "capturing an identifier of the

originating merchant location from which the specific processing request was sent over the

originating communications network, deeming that the originating merchant location is a

trusted source based upon its use of a trusted communications network, and storing the

captured identifier of the originating merchant location in the database as a trusted merchant

location for future processing requests, if not already stored in the database"

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 1, 8, 16, 17, 19, 20, 22, 25, 27, 28, 42-43, 50, 51, 53, 54, 56, 61 and 68-71 are

rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description

requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1 and 42 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not provide a written description disclosure to support the claimed limitations as discussed in the objections to specification above. Similar reasoning and logic apply to the dependent claims. Dependent claims 8, 16, 17, 19, 20, 22, 25, 27, 28, 43, 50, 51, 53, 54, 56, 61 and 68-71 are also rejected by virtue of dependency on a rejected independent claim.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 1, 8, 16, 17, 19, 20, 22, 25, 27, 28, 42-43, 50, 51, 53, 54, 56, 61 and 68-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 42 recite the limitations "a plurality of records comprising information identifying specific merchant locations, if any, and information identifying specific communications networks for carrying or transmitting stored value card processing requests, if any, that are authorized to transact specific processing requests for a stored value card" and "capturing an identifier of the originating merchant location from which the specific processing request was sent over the originating communications network, deeming that the originating merchant location is a trusted source based upon its use of a trusted communications network, and storing the captured identifier of the originating merchant location in the database as a trusted merchant location for future processing requests, if not

already stored in the database". The scope of the claims is indefinite because the Specification,

as originally filed, fails to disclose any algorithms to adequately describe sufficient

corresponding structure for performing the functions or fails to disclose any steps to adequately

describe the claimed functions. Dependent claims are rejected by virtue of dependency on a

rejected claim.

Claim 8 claims a method but recite the features of a system (e.g. "wherein the originating

communications network is a dedicated data circuit"). The claim is not sufficiently precise due

to the combining of two different statutory classes of invention in a single claim. The preamble

the claim refers to a method, but the body of the claim discusses the specifics of a system. A

claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen,*

Inc. v. Chugai Pharm. Similarly Claim 25 claims a method but recite the features of a system

(e.g. "wherein each record stored in the database further includes ….."). Similar defects are

present in claims 70 and 71.

Claim 52 claims a system but recite the features of a method (e.g. "wherein the request is

transmitted over the internet"). The claim is not sufficiently precise due to the combining of two

different statutory classes of invention in a single claim. The preamble the claim refers to a

system, but the body of the claim discusses the specifics of a method. A claim is considered

indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm.*

Similarly Claim 53 claims a system but recite the features of a method (e.g. "wherein the

originating merchant location is identified by a static IP address .."). Similar defects are present

in claims 54 and 56.

Claim Interpretation

8.   Claims 1 and 42 recite the limitation "a plurality of records comprising information

identifying specific merchant locations, if any, and information identifying specific

communications networks for carrying or transmitting stored value card processing requests, if

any". The Examiner has interpreted this limitation to mean that there may be some records that

identify specific merchant locations only and there may be some that identify specific

communications networks only and there may be some that identify both.

Claims 8, 16, 17, 19, 20, 22, 25, 27, 43, 50, 51, 53, 54, 56, 61, 68, 70 and 71 include

"wherein" clauses. The "wherein" clauses in these claims describe the intended use of the

limitations they are associated with. For instance in claim 8, the clause "wherein said stored-

value card is selected from the group consisting of: a gift card, a prepaid gas card, a prepaid

grocery card, a prepaid entertainment card, a card used for downloading ring tones, a card used

for downloading software, a card used for downloading music files, and a customer rewards

card" describes the stored-value card, and not the steps of storing the request, or processing the

request. The intended use language in the claim merely states the result of the limitation in the

claim and adds nothing to the patentability or substance of the claim. [See *Texas Instruments Inc.*

v. International Trade Commission, 26 USPQ2d 1010 (Fed. Cir 1993); *Griffin v. Bertina*, 62

USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747

(Fed. Cir. 2001). Hence the intended use limitations are not given patentable weight. Similarly in

claims 16, 17, 19, 20, 22, 25, 27, 43, 50, 51, 53, 54, 56, 61, 68, 70 and 71 the "wherein" clauses

are interpreted as intended use limitations that do not further limit the claim.

In general, the grammar and intended meaning of terms used in a claim will dictate

whether the language limits the claim scope. Language that suggests or makes optional but does

not require steps to be performed or does not limit a claim to a particular structure does not limit

the scope of a claim or claim limitation. The following are examples of language that may raise a

question as to the limiting effect of the language in a claim:

> (A) statements of intended use or field of use,

> (B) "adapted to" or "adapted for" clauses,

> (C) "wherein" clauses, or

> (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

The rejections given below are interpreted in light of the 35 USC rejections and the claim

interpretation discussed above.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   Claims 1, 8, 16, 17, 19, 20, 22, 25, 27, 28, 42-43, 50, 51, 53, 54, 56, 61 and 68-71 are

rejected under 35 U.S.C. 103(a) as being unpatentable over Lorsch (US Patent 5,903,633) in

view of Van Hoff (US Patent 6,381,631 B1).

Claims 1 and 42, Lorsch teaches a computerized method and a system for securely

authorizing and transacting specific processing requests for stored-value cards from an

originating merchant location over an originating communications network, the method

comprising: storing in a database coupled to a central processor a plurality of records

comprising information identifying specific merchant locations, if any, and information

identifying specific communications networks for carrying or transmitting stored value card

processing requests, if any, that are authorized to transact specific processing requests for a

stored value card, each of the specific merchant locations and specific communications

networks identified by an identifier (See the entire document of Lorsch especially Abstract,

Figures 1-2, Column 3 lines 25-65 and Column 7 line 27- Column 8 line 10); receiving at the

central processor a processing request for a stored-value card along with the identifier of the

originating merchant location or the originating communication network (See the entire

document of Lorsch especially Abstract, Column 7 line 27- Column 8 line10); determining at

the central processor whether the received identifier of the originating merchant location or the

originating communication network is stored in the database as a trusted source for making the

specific processing request (See the entire document of Lorsch especially Abstract, Column 7

line 27- Column 8 line10); responsive to a determination that the received identifier is

associated with a trusted merchant location that is stored in the database as a trusted source for

making the specific processing request, performing the specific processing request (See the

entire document of Lorsch especially Abstract, Column 7 line 27- Column 8 line10). A system

for performing the above steps is inherent in the disclosure of Lorsch.

   Lorsch does not explicitly teach the steps of storing in a database coupled to a central

processor a plurality of records identifying specific communications networks for carrying or

transmitting stored value card processing requests, which may include the originating

communication network, that are authorized to transact specific processing requests, each of

the specific communications networks identified by an identifier; responsive to a determination that the received identifier is associated with a trusted communication network for making the specific processing request for the stored value card, performing the specific processing request ; and capturing an identifier of the originating merchant location from which the specific processing request was sent over the originating communications network, deeming that the originating merchant location is a trusted source based upon its use of a trusted communications network, and storing the captured identifier of the originating merchant location in the database as a trusted merchant location for future processing requests, if not already stored in the database.

That the specific processing request is for processing the stored value card is already taught by Lorsch. Van Hoff teaches the steps of storing in a database coupled to a central processor a plurality of records identifying specific communications networks for carrying or transmitting processing requests, that are authorized to transact specific processing requests, each of the specific communications networks identified by an identifier (See the entire document of Van Hoff especially Abstract, Column 3 lines 53-60, Column 8 line 33 – Column 12 line 62); responsive to a determination that the received identifier is associated with a trusted communication network for making the specific processing request, performing the specific processing request (See the entire document of Van Hoff especially Abstract, Column 8 line 33 – Column 12 line 62); and capturing an identifier of the originating merchant location from which the specific processing request was sent over the originating communications network (See the entire document of Van Hoff especially Abstract, Column 5 line 9—Column 6 line 2), deeming that the originating merchant location is a trusted source based upon its use

of a trusted communications network, and storing the captured identifier of the originating

merchant location in the database as a trusted merchant location for future processing requests

if not already stored in the database (See the entire document of Van Hoff especially Abstract,

Column 5 line 9 - Column 6 line 2 and Column 8 line 49 – Column 9 line 17; storing digital

representation of the identification and updated information including dial in sequences are

interpreted to include these features).

It would have been obvious to one of ordinary skill to combine the teachings of Van

Hoff to the invention of Lorsch. The motivation to combine is that it would have helped a user

to connect to third parties that are trusted by the system administrator (See Van Hoff Column 3

lines 26-29).

Also in the alternative, to add an item of information to the database after the item has

been found to be authentic is old and well known. For instance when a new peripheral device is

connected to a computer, the computer requests that the new device be authenticated. Once

affirmed, the device is added to the list of devices that the computer is authorized to use. This

way users benefit because do not have to authenticate every device after every login.

Claim 8, the steps wherein said stored-value card is selected from the group consisting

of: a gift card, a prepaid gas card, a prepaid grocery card, a prepaid entertainment card, a card

used for downloading ring tones, a card used for downloading software, a card used for

downloading music files, and a customer rewards card are old and well known uses of a stored

value card. These features make them useful as gift cards also.

Claims 16 and 50, Lorsch teaches the step wherein the originating communications

network is a dedicated data circuit (See Lorsch Column 3 lines 16-65).

Claims 17 and 51, Lorsch teaches the step wherein the specific processing request is a request to activate, deactivate, reload, refresh, or refund the stored value card (See Lorsch Column 3 lines 35-45, and claim 4).

Claims 19 and 53, Lorsch teaches the step wherein the originating merchant location is identified by a static IP address, and the determining step is based on whether the static IP address is recoded in the database as a trusted source of processing requests (See Lorsch Abstract, Column 7 line 27- Column 8 line10, location of merchant is interpreted to include a static IP address).

Claims 20 and 54, Lorsch teaches the step wherein the originating merchant location is identified by a static IP address, the originating merchant location enters a password to access a network wherein the password is based on or identical to the static IP address, the originating merchant location communicates with the central processor using the static IP address, and the determining step is based on whether the static IP address is recorded in the database as a trusted source of processing requests (See Abstract, Lorsch Column 7 line 27- Column 8 line 10, location of merchant is interpreted to include an assigned static IP address).

Claims 22 and 56, Lorsch teaches the step wherein the request is transmitted over a public switched telephone network and the merchant location is determined to be a trusted source by performing a step selected from the group consisting of: identifying the telephone number used by the merchant location and communicating an acceptable password or merchant location identifier to the central processor (See Abstract, Lorsch Column 6 lines 35-50 and Column 7 line 36 - Column 8 line 7).

Claim 25, Lorsch teaches the step wherein each record stored in the database further includes a parameter corresponding to the value associated with each respective stored-value card selected from the group consisting of: parameters indicative of predefined time units and parameters indicative of one or more predefined dollar values (See Abstract, Lorsch Column 8 lines 35-40).

Claim 27, Lorsch teaches the step wherein the request to activate, deactivate, reload, refresh, or refund a stored value card is a request for changing a value associated with a respective stored-value card, the request being transmitted to the central processor from an originating merchant location, the central processor configured to accept the request to activate, deactivate, reload, refresh, or refund a stored value card based on whether the respective identifiers stored in the record for the stored-value card match identifiers actually transmitted by the originating merchant location for that stored-value card (See Abstract, Lorsch Column 7 line 36 - Column 8 line 7 and Column 8 lines 40-52, adding minutes implies changing a value associated with a respective stored-value card).

Claim 28, Lorsch teaches the step comprising selectively encoding the requests to activate or deactivate based on a table of predefined codes stored in the database, the predefined codes being associated with respective user groups or locations (See Lorsch Column 5 line 32 - Column 6 line 5).

Claims 43, Lorsch teaches the steps wherein the specific processing request is selected from a group consisting of: a request to change a status of the stored-value card, a request to activate the stored-value card, a request to deactivate the stored-value card, a request to change the value of the stored-value card, a request to refresh the stored-value card, and a request to

redeem the value of the stored-value card (See Lorsch Column 5 line 32 - Column 6 line 5 and

Column 7 line 27 - Column 8 line 52, adding minutes implies changing a value associated with

a respective stored-value card).

Claim 61, Lorsch teaches the feature wherein said stored-value cared is a card used for

a purpose, selected from the group consisting of: downloading music files, downloading of

games, enabling long distance telephone communication, enabling wireless communication,

enabling paging services, enabling internet communication services, and enables wireless web

access (See Lorsch Column 4 lines 32-47).

Claim 68, Lorsch teaches the step wherein receiving at the central processor a request

from a customer to add stored value to a customer account, the request including a first

identifier, wherein the first identifier and the stored value are associated with the stored-value

card, and wherein the customer account is managed by a provider (See Lorsch Column 8 lines

33-67); and providing from the central processor a provider identifier associated with the

provider to the customer, wherein the provider identifier is effective to add the associated

stored value to the customer account (See Lorsch Column 3 line 45 - Column 4 line 10, the

return code is interpreted to include the provider identifier).

Claims 69-71, Lorsch teaches the steps of establishing at the central processor

communication between the customer and a provider communications system managed by the

provider (See Lorsch Column 4 lines 37-47); wherein the provider communications system is an

interactive voice recognition (IVR) system (using a special telephone number implies this feature

in view of the other disclosure); and wherein the provider communications system is configured

to add associated stored value to the customer's account after receiving the provider identifier

from the customer (See Lorsch Column 4 lines 15-63, activated PINs implies this feature).

Response to Arguments

11.   In response to Applicant's assertion "Lorsch fails to (1) use identifiers of a terminal or

point of sale location to determine if a requested transaction is authorized; (2) use identifiers of a

location or communications network to determine - after connected - whether the specific

requested transaction is authorized", the Examiner respectfully disagrees. In Column 7 lines 28-

37 and lines 46-67, Lorsch clearly discloses these features. Lorsch uses identifiers of a location

(automated number identification (ANI) technology and point-of-sale terminals clearly imply

identifiers of a terminal or point of sale location). In response to Applicant's assertion "Lorsch

fails to … (3) use a network as an indicator of the trustworthiness of a merchant location, and

based upon the network, considering and recording the merchant location as a trusted source",

the Examiner would like to point out the Lorsch is not relied upon to teach this feature. This

feature is taught by Van Hoff.

       In response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e.," use

identifiers of a location or communications network to determine - after connected - whether the

specific requested transaction is authorized") are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification are not

read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

       In response to Applicant's assertion that Van Hoff fails to disclose, teach or suggest "

"[D]etermining at the central processor whether the received identifier of the originating

merchant location or the originating communication network is stored in the database as a trusted

source for making the specific processing request for the stored value card."

"[R]esponsive to a determination that the received identifier is associated with a trusted

communication network for making the specific processing request for the stored value card;

performing the specific processing request for the stored value card."

"[C]apturing an identifier of the originating merchant location from which the specific

processing request was sent over the originating communications network, deeming that the

originating merchant location is a trusted source based upon its use of a trusted communications

network, and storing the captured identifier of the originating merchant location in the database

as a trusted merchant location for future stored-value card processing requests"", the Examiner

respectfully disagrees. That the specific processing request is for processing the stored value card

is already taught by Lorsch. Van Hoff especially Abstract, Column 3 lines 53-60, Column 8

line 33 – Column 12 line 62 clearly discloses determining at the central processor whether the

received identifier of the originating communication network is stored in the database as a

trusted source for making the specific processing. Also Van Hoff especially Abstract, Column 8

line 33 – Column 12 line 62 teaches responsive to a determination that the received identifier is

associated with a trusted communication network for making the specific processing request,

performing the specific processing request. The specific processing request in the example of

Van Hoff is access (read or write) a storage area. Finally Van Hoff teaches capturing an

identifier of the originating merchant location from which the specific processing request was

sent over the originating communications network, deeming that the originating merchant

location is a trusted source based upon its use of a trusted communications network, and storing

the captured identifier of the originating merchant location in the database as a trusted merchant

location for future processing requests especially Abstract, Column 5 line 9—Column 6 line 2

and Column 8 line 49 – Column 9 line 17; storing digital representation of the identification

and updated information including dial in sequences are interpreted to include these features).

Hence the combination of Lorsch and Van Hoff teach all the claimed features.

      In response to Applicant's argument "neither reference - taken alone or in combination -

teach the use a network as an indicator of the trustworthiness of a merchant location, and based

upon the network, considering and recording the merchant location as a trusted source. Nor is it

proper to consider it obvious to combine these references to disclose such aspects of the

invention. Any efforts do so would be solely based upon impermissible hindsight", the Examiner

respectfully disagrees. As already discussed in the rejections and in the preceding response to

arguments, Van Hoff teaches the use of a network as an indicator of the trustworthiness of a

merchant location and Lorsch teaches using the merchant location as a trusted source. Van Hoff

discloses that once the user is authenticated after using a trusted communication network, the

digital representation of the identification of the user is stored for future logins. The motivation

to combine the two references is that it would help a user to connect to third parties that are

trusted by the system administrator. This motivation is found in Van Hoff Column 3 lines 26-

29.

      Also in response to applicant's argument that the examiner's conclusion of obviousness is

based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971). Also the motivation to combine the two references is that it would

help a user to connect to third parties that are trusted by the system administrator. This

motivation is found in Van Hoff Column 3 lines 26-29.

      Applicant's other arguments with respect to pending claims have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure are listed on the enclosed PTO-892.

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

      A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles R. Kyle can be reached at (571) 272-6746. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3695

October 17, 2011